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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,579	12/07/2001	Nicholas Palahnuk	PW 068802 272092	6136

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EXAMINER

BLANCO, JAVIER G

ART UNIT PAPER NUMBER

3738

DATE MAILED: 02/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/017,579

Applicant(s)

PALAHNUK ET AL.

Examiner

Javier G. Blanco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims 4 and 10 are objected to because of the following informalities:
 - a. Regarding claim 4, please substitute “substance” (see line 2) with --material-- (see specification at page 4, lines 22-23).
 - b. Regarding claim 10, please substitute “substance” (see line 2) with --material-- (see specification at page 4, lines 22-23).
- Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 1-5, 7, 8, 10, and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - a. Regarding claim 1, “the adhesive device” (see line 4) lacks antecedent basis. Claims 2-5 depend on claim 1.
 - b. Regarding claim 5, the limitation “folded above the position of the polymer strip” (see lines 1-2) is confusing and renders the claim vague and indefinite. Examiner respectfully suggests: --folded above its position with the polymer strip-- (or similar claim language).
 - c. Regarding claim 7, “the adhesive device” (see line 5) lacks antecedent basis. Claims 10 and 11 depend on claim 7.

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- d. Regarding claim 8, “the adhesive device” (see line 1) lacks antecedent basis.
- e. Regarding claim 11, the limitation “folded above the position of the polymer strip” (see lines 1-2) is confusing and renders the claim vague and indefinite. Examiner respectfully suggests: --folded above its position with the polymer strip-- (or similar claim language).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 6, 8, and 9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by West (US 3,286,576).

As seen in Figures 2-4, West discloses a method for enlarging lips, the method comprising (i) stretching a mucosal area of a human lip in order to evert a portion of the lip, and (ii) adhering (Merriam-Webster dictionary defines “adhering” as “*to hold fast or stick by or as if by gluing, suction, grasping, or fusing*”) a polymer (e.g., thermosetting plastic material; see column 3, lines 11-21 and lines 59-61) strip (see thin lower portion 18 of member 10; Merriam-Webster dictionary defines “strip” as “*a long narrow piece of a material*”) to the stretched mucosal area, to maintain the lip in an everted position (see column 3, lines 22-33).

6. Claims 12-15 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Shapiro (US 5,462,067).

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As seen in Figures 1-3, Shapiro discloses an apparatus comprising a polymer strip (e.g., polymeric film 12) sized and configured to fit within a mucosal area of a human lip (see Figure 3), and an adhesive (e.g., adhesive strip 21) attached to the polymer strip. Regarding the limitation “for adhering the polymer strip to the mucosal area of a human lip” (see claim 12, lines 3-4):

- a. It is noted that the law of anticipation does not require that the reference “teach” what the subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).
- b. The structure of the Shapiro device has the ability to perform the function recited in the claims if one so desires. It has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Allowable Subject Matter

7. Claim 1 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

8. Claim 7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Martin et al. (US 4,338,928), Horst (US 5,152,300), Maness (US 6,003,515), Sempere et al. (US 6,318,370), Amernick (US 6,328,756), and Byers (US 6,652,275).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 703-605-4259. The examiner can normally be reached on M-F (7:30 a.m.-4:00 p.m.), first Friday of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 703-308-2111. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306 for regular communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

JGB



February 6, 2004



David H. Willse
Primary Examiner